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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,638	07/20/2001	Nathan R. Brown	500200.05	3241
27076	7590	07/02/2004	EXAMINER GRANT, ALVIN J	
DORSEY & WHITNEY LLP INTELLECTUAL PROPERTY DEPARTMENT SUITE 3400 1420 FIFTH AVENUE SEATTLE, WA 98101			ART UNIT 3723	

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/910,638	<b>Applicant(s)</b> BROWN, NATHAN R.	
	<b>Examiner</b> Alvin J Grant	<b>Art Unit</b> 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 54-56 and 58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-56 and 58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/27/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 54, 55, 56 and 58** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yu '699 in view of White '070.

Yu discloses a method for removing material from a microelectronic substrate, comprising: engaging the microelectronic substrate with a planarizing medium, which includes a polishing pad; moving at least one of a first part of the microelectronic substrate and the planarizing medium relative to the other at a first rate; moving at least one of a second part of the microelectronic substrate and the planarizing medium inwardly relative to the other at a second rate less than the first rate; removing material from the first and second parts of the microelectronic substrate at approximately equal rates (or uniform rates) by biasing the first part of the microelectronic substrate against the planarizing medium with a first membrane portion having a first thickness and biasing the second part of the microelectronic substrate against the planarizing medium with a second membrane portion having a second thickness greater than the first thickness (column 2, lines 60-63); the second annular part of the microelectronic substrate positioned radially inwardly from the first annular part of the microelectronic substrate; the membrane has a first surface facing toward the microelectronic substrate and a second surface facing generally opposite the first surface (Fig. 7; and column 3, lines 4-22), and wherein biasing the microelectronic substrate against the planarizing medium includes biasing a generally flat support member against the second surface of the membrane. Yu does not specifically disclose a planarizing medium that includes advancing the polishing pad from a supply roller to a take-up roller. However, the use of linear polishing pads that extend between polishing wheels that move them in a linear direction, is well known in the art. White, for

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example, discloses the use of a planarizing medium that includes advancing the polishing pad from a supply roller to a take-up roller so as to move the used portion of the pad away from the planarizing zone thus providing for a clean pad during the planarizing process. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used a take-up roller in the apparatus of Yu as taught by White so as to move the used portion of the pad away from the planarizing zone thus providing for a clean pad during the planarizing process.

### ***Response to Arguments***

Applicant's arguments filed 24 May 2004 have been fully considered but they are not persuasive. In response to Applicant's arguments that the Yu reference fails to disclose, or suggest in any motivated sense that the planarization medium may be moved from a supply roller to a take-up roller, it has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969). Furthermore, White discloses the use of a planarizing medium that includes advancing the polishing pad from a supply roller to a take-up roller so as to move the used portion of the pad away from the planarizing zone thus providing for a clean pad during the planarizing process.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 54, 55, 56 and 58** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over **claims 1-9** of U.S. Patent No. 6,296,557. Although the conflicting claims are not identical, they are not patentably distinct from each other because even though Patent No. 6,296,557 (Walker) does not specifically disclose varying the removal rates of material from the substrate by biasing it relative to the planarizing medium, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have biased the substrate of Walker relative to the planarizing surface thus impacting the pressure on the surface and hence the planarizing rate.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J Grant whose telephone number is (703) 305-3315. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J Hail can be reached on (703) 308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajg

A handwritten signature in black ink, appearing to read "Joseph J. Hail, III". The signature is fluid and cursive, with a stylized "H" and "I" at the end.

Joseph J. Hail, III  
Supervisory Patent Examiner  
Technology Center 3700